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Paper No. 7

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650 Page Mill Road
Palo Alto, CA 94304

In re Application of
Ben-Zur et al.
Application No. 09/662,681
Filed: September 15, 2000
For: Interface Receiver For Communications
Among Network Elements

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OFFICE OF PETITIONS
AVC PATENTS
DECISION REFUSING STATUS
UNDER 37 CFR 1.47(a)

This is in response to the petition filed January 29, 2001, pursuant to the provisions of rule 37 CFR 1.47(a).

The petition is dismissed.

Rule 47 applicant is given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition under 1.47(a)," and should only address the deficiencies noted below. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on September 15, 2000 with a declaration, and naming Raanan Ben-Zur, Boris Reynov, Bayne G. Steele, and Ohm P. Mishra as joint inventors. The declaration was signed by inventors Raanan Ben-Zur, Boris Reynov, and Ohm P. Mishra, but not by inventor Bayne G. Steele.

Accordingly, on November 29, 2000, a "Notice to File Missing Parts of Application" was mailed indicating that the signature of joint inventor Bayne G. Steele was missing, and requiring an oath or declaration in compliance with 1.63 and a \$130 surcharge for its late filing.

In response, on January 29, 2001, petitioner submitted the instant petition and \$130 fee, a \$130 surcharge, a declaration of facts and evidence in support of the petition, the last known address of the non-signing inventor, and a copy of the declaration pursuant to 37 CFR 1.63 submitted on September 15, 2000.

The declaration of facts presented by Mr. Richard L. Gregory, the attorney of record in the instant application, states that a combined Declaration and Power of Attorney and an Assignment were sent to Bayne G. Steele at his last known address via U.S. Postal Service on December 5, 2000 and the documents were returned marked "Unclaimed" and on January 5, 2001 the Declaration and Assignment were again sent via Federal Express and the documents were returned with a message marked "the recipient address on the air bill is incorrect or incomplete". The declaration further states that a telephone call was placed to the last known telephone number of inventor Steele and a message was

received indicating that the number was disconnected. Lastly, the declaration states that an electronic search for contact information for inventor Steele was made, and none of the attempts to locate inventor Steele were successful.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims, and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; (4) a statement of the last known address of the non-signing inventor. Applicant lacks item(s) (1) as set forth above.

As to item (1), the applicable statute (35 USC 116) requires that a "diligent effort" have been expended in attempting to find or reach the nonsigning inventor. See MPEP 409.03(a). The showing currently fails to demonstrate, with a documented showing, that a diligent effort was made to find or locate inventor Steele, such that the declaration can be accepted under 37 CFR 1.47(a).

Where inability to find or locate a named inventor(s) is alleged, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a *diligent effort* was made to locate the inventor. While it is recognized that an attempt was made to deliver papers (albeit no mention is made of the application papers) to the last known address of the inventor and that these papers were returned as undeliverable and that the last known address of inventor Steele was obtained from his former employee, Cyras Systems, Inc. (Cyras), the showing currently fails to demonstrate, with a documented showing, that all possible efforts were made to find or locate inventor Steele such that the declaration can be accepted under 37 CFR 1.47(a). More specifically, petitioner should demonstrate other attempts to locate nonsigning inventor Steele. In this regard, have any of inventor Steele's former co-workers kept in touch with him? Does Rule 47 applicant have access to Cyras' personnel records, and, if so, what does inspection of the records reveal as to a current address, forwarding address, or an address of the nearest living relative? What does inspection of the phone directories for those address locations reveal? Has petitioner attempted to locate inventor Steele on the Internet?¹ While the declaration of Mr. Gregory, Jr., states that an electronic search for contact information for inventor Steele was made, the declaration did not indicate the method used in conducting the search and no evidence of the search results has been made of record. If inventor Steele is located, then a copy of the complete application papers (specification, claims, drawings, oath or declaration) must be mailed to inventor Steele, return receipt requested. Copies of documentary evidence, such as returned mail receipt showing proof of service on inventor Steele, cover letter of instructions, telegraphs, E-mail, etc., to support a showing that the application papers and oath or declaration were sent to inventor Steele's current or last known address must be submitted and to support a conclusion that inventor Steele could not be reached or located to join in the instant application or that he refused to accept delivery of the application papers. However, if the papers are returned with a current or forwarding address, petitioner should mail a copy of the application papers to the forwarding address, return

¹ A brief Internet search found two Bayne Steele's at telephone numbers (707) 762-4330 in California and (919) 603-5567 in North Carolina.

receipt requested, requesting that inventor Steele sign the oath or declaration after reviewing the application papers. The cover letter of instructions should include a deadline or a statement that no response will constitute a refusal. This sort of ultimatum lends support to a finding of refusal by conduct. The proof of the pertinent events should be made in a statement by someone with firsthand knowledge of the events and must be supported by documentary evidence. See MPEP 409.03(d).

If after having presented the nonsigning inventor with a copy of the application papers, there is an express oral refusal, that fact, along with the time and place of the refusal, must be stated in an affidavit or declaration. Statements by a party not present when an oral refusal is made will not be accepted. Where there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration. See MPEP 409.03(d).

In order to expedite consideration of the petition under 37 CFR 1.47(a), petitioner may wish to consider submitting the renewed petition by facsimile transmission to the telephone number indicated below and to the attention of Latrice Bond.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Office of Petitions
 Assistant Commissioner for Patents
 Box DAC
 Washington, D.C. 20231

By FAX: (703) 308-6916
 Attn: Office of Petitions

By hand: Office of Petitions
 Crystal Plaza Four, Suite 3C23
 2201 South Clark Place
 Arlington, VA 22202

Telephone inquiries related to this decision should be directed to Latrice Bond at (703) 308-6911.

Frances Hicks
Frances Hicks
Lead Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy